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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,896	02/13/2002	Joy M. Campbell	P04890US1	6473

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EXAMINER	
BERTOGLIO, VALARIE E	
ART UNIT	**PAPER NUMBER**
1632	

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/074,896	CAMPBELL ET AL.	
	Examiner	Art Unit	
	Valarie Bertoglio	1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14,17,29 and 30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14,17,29 and 30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on *N/A* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Close

DETAILED ACTION

Applicant's reply filed 03/03/2005 has been received. Claims 1-7,12,14,17 have been amended. Claims 15,16 and 18-28 are cancelled. Claims 29 and 30 have been added. Claims 1-14,17,29 and 30 are pending and under consideration in the instant office action.

Claim Objections

Claims 5 and 6 are objected to because of the following informalities:

The phrases "up to about 0.05-3.0%" and "up to about 0.1-1.5%" in claims 5 and 6 are objected to because the specification teaches concentrations within the range of 0.05 to 3.0% but does not teach concentrations less than 0.05% that appear to be encompassed by the claims. Amending the claims to read "from about 0.05%..." or "from about 0.1%..." would more clearly convey the teachings of the specification.

Appropriate correction is required.

Claim 30 is objected to because of the following informalities:

Claim 30 reads "and decrease the yield" where it should read "and decreases the yield".

Appropriate correction is required.

Double Patenting

The rejection of claims 1-4, 7-9, 11-14 and 17 is maintained and newly added claims 29 and 30 are rejected and under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 6-8 of U.S. Patent No. 6,004,576. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims encompass a method of increasing weight in poultry using an animal supplement comprising animal plasma. Therefore the claims of '576 anticipate the instant claims.

Applicants' arguments regarding this rejection have been thoroughly considered and are not found persuasive. The rejection is maintained for reasons of record set forth on pages 2-3 of the office action mailed 09/01/2004 and reiterated below.

Applicant has argued that an inherent feature must be supported by factual grounds that the inherent feature must flow as a necessary conclusion (page 7, paragraph 1 of Applicant's remarks) and is not simply a possible conclusion.

Claims 1 and 7 of '576 specifically claim increasing weight gain in poultry, namely ducks, turkeys and chickens (see '576, claim 7) in the first stages of life by feeding dried plasma as a food supplement. The instant specification teaches feeding dried plasma to Jumbo Cornish X Rock Broilers at one day old. The claims are drawn to a method comprising administering a supplement comprising animal plasma to poultry to increase the yield of breast meant in the poultry. The difference between '576 and the instant invention is only the outcome, which is the effect that is naturally carried out in the poultry in the identical processes of '576 and the claimed invention. There is nothing different about the poultry of the instant claims that would render the outcome of the claimed method any different than that of the methods of '576. The instant specification shows that practicing the method of claim 7 of '576 results in increased breast meat in the broilers. "Discovery of new property or use of previously known composition, even if unobvious from prior art, cannot impart patentability to claims to known composition". In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Practicing claim 7 of '576 cannot occur without infringing on the claims 1-4, 7-9, 11-14 and 17, 29 and 30 of the instant invention.

Dependent claims are included in this rejection as set forth on pages 2-3 of the office action mailed 09/01/2004. Applicant did not provide an arguments specific to these claims.

Claim Rejections - 35 USC § 112-1st paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

New Matter

The rejection of claims 1-7,14,16 and 17 as containing new matter is withdrawn in light of Applicant's remarks and amendments to the claims.

Enablement

The rejection of claim 10 under 35 U.S.C. 112, first paragraph, is withdrawn in light of Applicant's remarks.

Applicant has made it of record that the transgene would not cause the animal to be a more effective source of plasma. Therefore, the plasma of transgenic animal of claim 10 does not differ from the plasma of any non-transgenic animal in the claimed methods.

Claim Rejections - 35 USC § 112-2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The previous rejection of claims 1-14,16,17,22,27 and 28 under 35 USC 112, 2nd paragraph is withdrawn in light of Applicant's amendments to the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of claims 1-4,7-14 and 17 is maintained and is applied to newly added claims 29 and 30 under 35 U.S.C. 102(b) as being anticipated by Weaver (US 6,004,576, 1999). Applicant's arguments have been thoroughly considered and are not found persuasive. The rejection is maintained for reasons of record set forth on pages 8-9 of the office action mailed 09/01/2004.

Applicant argues that the claims are a new use of a known composition (see page 9, paragraph 6 of Applicants' remarks).

In response, the claimed methods are methods of using animal plasma that are identical in scope to those of '576. Each method step of the rejected claims is taught by '576 using the same plasma product on the same animal species. It is inherent that the outcome, whether described by '576 or not, would be the same. '576 characterized the result as increased weight gain. Applicant argues that only some tangible difference must be shown to overcome anticipation. In response, there is not tangible difference between the claimed method steps and the teachings of '576. Applicant argues that an inherent feature must flow as a necessary conclusion. In response, because the claimed method steps are taught by '576, the result obtained is necessarily obtained. With the exception of the description of the result of the claimed methods, Claim 7 of '576

anticipates every limitation of the method steps of claim 1 of the instant invention. There is no material difference between the methods that would cause a different phenotypic outcome.

Therefore, the rejection is maintained as '576 anticipates the limitations of claims 1-4,7-14 and 17.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The rejections of claims 1-7,10,11,13,14 and 17, under 35 U.S.C. 103(a) as obvious over Adalsteinsson (US 6,086,878, effective filing date August 21, 1997) is maintained and applied to newly added claims 29 and 30. The rejection under 35 U.S.C. 103(a) is maintained and newly applied to claims 29 and 30 for reasons presented in the office action mailed 09/01/2004 and for further reasons set forth below.

As set forth on pages 10-11 of the office action mailed 09/01/2004, Adalsteinsson taught a method for increasing the live weight of poultry using spray dried egg yolk or plasma as a supplement in feed and water.

Applicant has argued that '878 is directed to methods of administering antibodies to animals (page 11, last paragraph). The instant claimed methods do not involve antibodies. Applicant argues that '878 discloses use of eggs or milk to deliver as a means to deliver antibodies from one animal to another and that at art worker would not have been motivated to administer plasma to animals because the plasma would not have concentrations of the desired

antibodies at the same concentration as would the eggs or milk. Applicant argues that nothing in '878 suggests that the direct administration of plasma would result in an increase in yield of breast meat (page 12, paragraph 2).

In response, '878 teaches using plasma in place of eggs or milk (col.2, lines 6-8; col. 7, lines 39-41; col. 8, lines 60-65). Whether or not administering plasma as opposed to eggs or milk would result in the same level of antibodies as eggs or milk is irrelevant. '878 teaches the method steps, and, as set forth for the 102 rejection above, such method steps would inherently result in the increase in breast meat at the expense of thigh and leg meat in poultry. Since it does not appear that the methods are different or that the plasma administered would be structurally or compositionally different than that of Adalsteinsson, then it is an inherent property of the methods taught by Adalsteinsson, being the same as those of the instant invention, that the methods will preferentially increase the yield of white meat from the poultry. The preferential increase in white meat as claimed in the instant invention is merely an unrecognized property of the methods of Adalsteinsson (see above).

Thus, the claimed invention is clearly *prima facie* obvious in the absence of evidence to the contrary.

Claim Rejections - 35 USC § 102/103

Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Weaver (US 6,004,576, 1999).

Applicant failed to address this rejection specifically and it is, therefore, maintained for reasons of record set forth on pages 11-12 of the previous office action mailed 09/01/2004.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Valarie Bertoglio whose telephone number is (571) 272-0725. The examiner can normally be reached on Mon-Fri 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Valarie Bertoglio
Examiner
Art Unit 1632

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PRIMARY EXAMINER

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